

Remarks

I. Status of the Claims

Upon entry of the foregoing amendment, claims 86-93, 95-100, 102-123, 125-132, 158-160 and 163-166 are pending in the application, with claims 86 and 87 being the independent claims. Claim 90 has been amended. Claims 1-85, 94, 101, 124, 133-157, and 161-162 have been canceled. New claim 166 has been added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

II. The Amendments

Claim 90 has been amended to delete the reference to the core α -1,6-fucosyltransferase. Claims 1-85, 94, 101, 133-149, 151-157, and 161-162 have been canceled without prejudice or disclaimer. Applicants reserve the right to file one or more continuing applications directed to the subject matter of the canceled claims. New claim 166 depends from claim 159 and recites that the recombinant antibody is expressed from one or more expression vectors introduced into the host cell after the host cell has first been glycoengineered. Support for new claim 166 can be found, *inter alia*, in the specification at page 32, which describes the co-transfection of CHO-tet-GnT III_m cells with the vectors pchCE7H and pchC7L. Accordingly, no new matter is believed to have been added by these amendments, and their entry is respectfully requested.

III. Priority

The Office has acknowledged that claims 91-93, 95, 98-100, 102-105, 109-113, 115-126, and 129-162 are entitled to priority of the filing date of U.S. Appl. No.

60/082,581 (April 20, 1998). Nevertheless, the Office maintains that claims 90, 94, 96, 97, 101, 106-108, 114, 127, and 128 are granted priority only as of the filing date of the instant application (August 5, 2003) because the Office contends that they do not have support in the parent applications. Applicants, however, reiterate that all of the claims of the present application are supported by the parent applications (60/082,581 and 09/294,584) and are therefore entitled to claim the benefit of priority of those applications. In particular, the Office is directed to Applicants' previous arguments and the Declaration of Dr. Umaña concerning the enablement and written description rejections, which the Office has acknowledged were persuasive. Moreover, Applicants have amended claim 90 and canceled claims 94 and 101, which specifically recited the core α -1,6-fucosyltransferase. Thus, the benefit of priority for all pending claims is proper.

IV. The Rejections

A. The Rejection Under 35 U.S.C. § 112, First Paragraph

At page 3 of the Office Action, the Office has rejected claims 90, 94 and 101 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office asserts that the specification does not support the broad limitation of altering the level of activity of the core α -1,6-fucosyltransferase in the host cell. Applicants maintain that this aspect of the invention is sufficiently described for the reasons noted in the previous Amendment and Reply. Nevertheless, without acquiescing in the propriety of the rejection, Applicants have amended claim 90 and canceled claims 94 and 101, thereby eliminating any specific reference to the core α -1,6-

fucosyltransferase in the claims. Reconsideration and withdrawal of the rejection is respectfully requested.

B. The Rejections for Obviousness-Type Double Patenting

The Office has maintained the rejection of claims 86-88, 90-91, 97-98, 102-103, 106-107, 110-113, 120-121, 123, 125, 129, 131-132, and 159-160 for obviousness-type double patenting over claims 1-10 of U.S. Patent No. 6,602,684 and over claims 1-27 of co-pending Application No. 11/199,232. The Office has also added claims 163-165 to the rejections.

Applicants submit herewith two Terminal Disclaimers which disclaim the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of U.S. Pat. No. 6,602,684 or the full statutory term of any patent that issues from U.S. Appl. No. Application No. 11/199,232, respectively. Applicants have also submitted a signed Statement Under 37 CFR §3.73(b) as well as a copy of the General Power of Attorney to Prosecute Applications from the assignee. In view of the submission of the Terminal Disclaimers, Applicants respectfully submit that the rejections for obviousness-type double patenting have been obviated, and may be withdrawn.

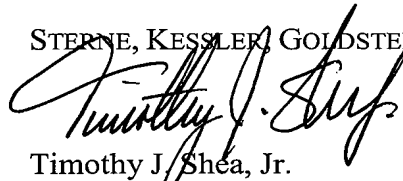
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. ***If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.***

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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